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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,145	05/23/2000	Paul Lapstun	NPA035US	9217

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EXAMINER	
PHAM, THIERRY L	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/575,145	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment.. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *RCE filed on 4/7/05*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 4/7/05.
- Claims 1-18 are pending in application; Claims 19-44 have been canceled.
- Updated status of the applications cited on pages 1-2 of the specification (i.e. patent number if the application have already been issued) has been received and acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (US 6330976), and in view of Ur (US 6072871).

Regarding claim 1, Dymetman discloses a method of printing a digital photograph (printing photographic images, fig. 4, col. 12, lines 58-67) including the following steps:

- transmitting (i.e. network as shown in fig. 9) instruction for printing the photograph to a printer (col. 12, lines 58-67) ;
- printing (printing photographic images onto a print media surface, col. 12, lines 58-67) the photograph onto a surface (i.e. marking medium, col. 7, lines 42-51) using the printer;
- also printing on the surface, coded data (i.e. location code uniquely defining the position of cell, col. 12, lines 40-45, and please notes, different codes such as page identification code can also be printed, col. 9, lines 15-21) indicative of an identity of the surface and at least one reference point on the surface, using the printer, such that an optical sensing device (optical sensing pointer 502, fig. 1), when placed in an operation position relative to the surface (optical sensing pointer 502 for sensing coded data printed on the document, i.e. marking medium), can generate indicating data using at least some of the coded data (marking medium 2 of fig. 1 contains coded data and wherein an optical sensing pointer 502 is implemented for detecting

location of the document and zones within the document's surface, figs. 3-7, col. 3, lines 39-67, col. 4, lines 24-35, col. 7, lines 42-67 and col. 8, lines 45-67), the indicating data comprising data regarding the identity of the surface and data regarding a position of the sensing device relative to the surface (optical sensor pointer 502 for detecting/sensing the marking medium's location/position/zones of the document's surface, col. 8, lines 40-67 to col. 9, lines 1-22, and col. 11, lines 28-45), whereby a computer system (optical sensor pointer 502 senses the coded data and transmits to a computer systems via a network 610, fig. 9, col. 8, lines 40-67 to col. 9, lines 1-22) can determine a photograph identity and/or an action relating to the photograph using at least some of the indicating data (i.e. retrieving a digital page of the printed document using an optical sensor pointer, and an optical sensor pointer for sensing the coded data printed on the document, figs. 1-2, cols. 7-9, and col. 11, lines 28-45 and figs. 13-15, also for Microsoft Word document and/or PowerPoint documents, col. 18, lines 45-55).

Dymetman teaches a method of printing document data and coded onto a print media surface, but fails to teach printing the coded data and photograph at the same time.

Ur, in the same field of endeavor for printing, teaches an ink jet printer (printer 17, fig. 1) prints the coded data at the same time as printing the document on the surface defining structure (prints coded data 27 and document texts as shown in fig. 2 at the same time, col. 4, lines 41-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the printing method of Dymetman to include a method of printing a coded data and photograph at the same time as per teaching of Ur because of a following reason: (1) a sensing device for sensing invisible coded data incorporated within the document (Dymetman, col. 12, lines 65-67); (2) reduce hardware costs and time by printing both coded data and document data simultaneously.

Therefore, it would have been obvious to combine Dymetman and Ur to obtain the invention as specified in claim 1.

Regarding claim 2, Dymetman further discloses a method according to claim 1 wherein the identify of the photograph is determined by an identification code (i.e. page ID, col. 32, lines 49-67) issued by a server which issues photograph identification codes.

Regarding claim 3, Dymetman further discloses a method according to claim 1 wherein a copy of the photograph may be requested by directing an optical sensing device (pointer 502, fig. 1) towards a zone (zone within document on the surface, col. 11, lines 28-42) on the surface, which causes the optical sensing device to sense coded data on the surface and transmit a message to a printer which in turns causes the printer to print a copy of the photograph.

Regarding claim 4, Dymetman further discloses a method according to claim 1 wherein a digital copy of the photograph (i.e. digital photograph is retrieved from a server via using coded data printed on surface of the document, col. 10, lines 15-47 and col. 12, lines 58-67 and col. 18, lines 45-56) is archived separately from the printed photograph and the original digital photograph.

Regarding claim 9, Dymetman further discloses a method according to claim 1 wherein data indicative of an action is forwarded from an optical sensing device to a printer when the optical sensing device is used to designate a particular zone of the surface (using zones, col. 16, lines 52-61).

Regarding claim 10, Dymetman further discloses a method according to claim 1 wherein the surface has printed on it one or more options which a user may select, each associated with a designated zone on the surface, and the user selects an option by moving an optical sensing device on the surface within the associated zone (using zones, col. 16, lines 52-61), the optical sensing device transmitting data indicative of the user's selection to a printer.

Regarding claim 11, Dymetman further discloses a method according to claim 1 wherein a user annotates the photograph with text by writing with an optical sensing device on the surface, data indicative of the movement of the optical sensing device being transmitted to a printer and converted to computer text (pointer device 502 for writing text on coded substrate, col. 17, lines 5-36).

Regarding claim 12, Dymetman further discloses a method according to claim 1 wherein a user signs the photograph by writing the user's signature on the surface with an optical sensing device (pointer device 504, col. 17, lines 10-35), data indicative of the movements of the optical sensing device being transmitted to printer, the signature thereafter being verified by comparison with a known signature of the user (signature authentication and handwriting recognition, col. 17, lines 5-35 and col. 22, lines 61-65).

Regarding claim 13, Dymetman further discloses a method according to claim 1 wherein a user requests one or more other documents or photographs to be printed (i.e. Fax icon, col. 22, lines 24-48) by directing an optic sensing device to a zone on the surface (zones, col. 16, lines 51-62).

Regarding claim 14, Dymetman further discloses a method according to claim 1 wherein a user requests one or more other documents or photographs to be printed by directing an optional sensing device to a zone on the surface (pointer 502 for sensing and retrieving documents to be printed via using coded data, col. 8, lines 45-67 and col. 9, lines 10-45).

Regarding claims 15-17, Dymetman teaches where the coded data is printed using an infrared ink and/or infrared-absorptive ink (cols. 11, lines 45-67 to col. 12, lines 1-25).

Regarding claim 18, the printer automatically binds the pages together are widely known in the art (i.e. copy machine with stapler options).

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ur and Dymetman as described in claim 1 above, and in view of McIntyre et al (U.S. 6102505).

Regarding claim 5, Ur and Dymetman teaches limitations (b) through (e) (see claim 1 above for more details), but does not teach a photograph is taking using a digital camera.

McIntyre, in the same field of endeavor for coded data, teaches a digital camera for taking digital photograph images (digital camera, fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ur as per teachings of McIntyre because of a following reason: (•) a digital camera which allows operator to take digital images and encrypted with barcodes.

Therefore, it would have been obvious to combine Tabata with McIntyre to obtain the invention as specified in claim 5.

Regarding claims 6-7, the combinations of Ur, Dymetman and McIntyre further teaches wherein the digital camera and printer form an integrated unit (fig. 1, col. 2, lines 55-67, McIntyre), the step of transmitting the digital photograph is done by means of a transmitter located in or proximate the integrated unit, the step of assigning an identification code is conducted on a computer (barcode is assign via file server and/or printer server, col. 6, lines 26-45) remote from the integrated unit, and the identification code is transmitted from the remote computer to the integrated unit before the digital photograph is printed (fig. 20, Tabata).

Regarding claim 8, the photograph identification code is also sent to a digital camera which took the photograph for future reference (image took by camera is also encrypted with barcodes, cols. 4, lines 50-67, McIntyre).

Response to Arguments

Applicant's arguments with respect to claims 1 & 5 have been considered but are moot in view of the new ground(s) of rejection due to newly added limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

GABRIEL GARCIA
PRIMARY EXAMINER